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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q61721

Tsuyoshi KITAHARA

Appln. No.: 09/708,514

Group Art Unit: 2861

Confirmation No.: 1708

Examiner: Judy NGUYEN

Filed: November 9, 2000

For: INK-JET RECORDING HEAD AND METHOD OF MANUFACTURING THE SAME

RESPONSE TO ELECTION OF SPECIES

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This paper is in response to the Office Action mailed June 10, 2004, for the above-identified application.

Applicants elect Species I, with traverse. The Applicants respectfully submit that claims 1, 3, 4 and 54 are readable on the elected Species. In addition to claim 1, noted by the Examiner to be generic, the Applicants respectfully submit that claim 4 is also believed to be generic.

Applicants reserve the right to file a Divisional Application directed to non-elected Species II.

Applicant's election is with traverse. MPEP 803 provides a two-prong test for judging whether a restriction/election requirement is proper:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (A) The invention must be independent ... or distinct as claimed ...; and
- (B) There must be a serious burden on the Examiner if restriction is required ...

(*See Id.*, internal citations omitted).

In the present case, the Examiner failed to satisfy at least prong (B) of the test set forth in MPEP 803. That is, the Examiner alleges that the search required for each one of the Species proposed by the Examiner is not required for the remaining Species. However, the Examiner has already performed searches for all of the Species, as evidenced by an earlier restriction requirement, two Office Actions, an Advisory Action, and an Interview Summary on the merits (see papers dated September 17, 2002, October 24, 2002, May 21, 2003, October 24, 2003 and January 30, 2004). In fact, the claims at issue have already been addressed in the two Office Actions. Furthermore, the feature that the Examiner has relied on to issue the Election of Species requirement has all along been included in the relevant claims in their original form. Clearly, the Examiner cannot now maintain that these same claims impose “a serious burden” on the Examiner and require restriction.

Notwithstanding the foregoing, 37 C.F.R. § 1.142 (a) provides that, a restriction requirement “will normally be made before any action on the merits; however, it may be made at any time before final action” (*see Id.*, emphasis added). MPEP 811.02 explains that “restriction is proper at any stage of prosecution up to final action” (*see Id.* emphasis added). In the present case, the Examiner has already issued a **final Office Action** and an Advisory Action and the Applicants have already submitted a Brief on Appeal. (see Office Action dated May 21, 2003).

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Thus, Applicant respectfully requests that the restriction and election requirements are improper and should be withdrawn.

Respectfully submitted,



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